

**Amendments to the Drawings:**

Replacement Figures 1-7 have been provided to overcome the informalities objected to by the Examiner. No new matter has been added.

Attached:      Replacement Drawings (7)  
                  Annotated Sheets Showing Changes (7)

## **REMARKS/ARGUMENTS**

The Applicant acknowledges, with thanks, the office action dated February 26, 2008, and completion of the personal interview of April 16, 2008. The Examiner's observations and suggestions are much appreciated and summarized herein.

The Examiner's acknowledgment of the Information Disclosure Statement submitted on September 30, 2003, is noted with appreciation. Claims 1-4, 5-12, and 14-16 are currently pending.

The drawings were objected to as failing to comply with 37 CFR §1.84(p)(5) because they do not include reference signs mentioned in the description. Corrected drawing sheets are being submitted herewith to overcome this objection. Fig. 7 has also been amended to correct an informality in the form of inadvertently transposed reference numbers, as noted on the attached annotated sheets showing the changes made.

Claims 1-32 were objected to under 37 CFR §1.75(a) as failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 1, 9, 17, and 25 were objected to for the limitation "a paper document" after such limitation was previously introduced. Claims 1 and 9 have been amended accordingly. Claims 17 and 25 have been cancelled.

Claims 3, 11, 19, and 27 were objected to for the limitation "a location of relevant markings" after such limitation had been previously introduced. Claims 3 and 19 have been amended accordingly. Claims 19 and 27 have been cancelled.

Claims 5, 7, 13, 15, 21, 23, 29, and 31 were objected to for the limitation "a paper document" after such limitation was previously introduced. Claims 7 and 15 have been amended accordingly. Claims 5, 13, 21, 23, 29, and 31 have been cancelled.

Claims 7 and 23 were objected to for the limitation "an image generating device" after the limitation "an image generating means" was claimed in claims 1 and 17. The image generating device specified in claim 7 is unique from the image generating means of claim 1. Claim 23 has been cancelled.

Claims 1-8 and 17-24 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. Claims 1-8 were amended to delete the term "adapted." Claims 17-24 were cancelled. Therefore, this rejection should be overcome.

Claims 1-32 were rejected under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Claims 1 and 9 were amended to provide that an output document is generated and communicated in a specified format to a destination. As such, the claims include a useful and tangible result. Claims 17-32 have been cancelled. As such, this rejection should be overcome.

Claims 17-32 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 17-32 have been cancelled. This rejection, therefore, should be overcome.

Claims 1-32 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,856,432 to Bobrow et al. (*hereinafter*, "Bobrow"). In view of the amendments and arguments set forth below, it is submitted that all pending claims are patentably distinct over the art of record.

The subject application is directed to a system and method for processing of electronic documents. An electronic representation of a paper document is generated, and an associated tangible template sheet is received, which template sheet is inclusive of a plurality of indicia corresponding to an instruction for a desired document processing operation and an instruction specifying a selected electronic document format. The instructions are optically recognized, and an instruction signal is generated in accordance with the recognized instructions. The operation of an associated document processing device on the electronic representation of the paper document is controlled in accordance with the instruction signal so as to generate an electronic document in the specified electronic document format, and an output document is generated. The output document is communicated in the specified electronic document format to a destination in accordance with the instruction signal.

As noted during the Interview, Bobrow is directed to a system that allows users to communicate instructions relative to facsimile operations. In one embodiment, a page includes check boxes, which specify routing of facsimile messages. Bobrow does not contemplate a need for accommodating different electronic document formats. In fact, different formats would run counter to the teachings of Bobrow, insofar as a document must be in a format for facsimile

transmission. Conversely, the subject application advantageously teaches scanning tangible media to create electronic image files in multiple optional formats, such as TIFF, multi-page TIFF, or PDF. Such formats are readily usable by applications, such as PDF editing, Adobe Acrobat, or image editing software. Such formats are also readily understood in their native form by printers.

Amendment to each of remaining independent claims 1 and 9 has been made to more patentably distinguish all claims over the art of record. By virtue of such amendment, all claims now include imitations wherein indicia are used specify desired document output format; as noted above, such is far removed from the teachings of Bobrow.

In accordance with the afore-noted amendments and comments, it is submitted that all claims are patentably distinct over the art and in condition for allowance thereover. An early allowance of all claims is respectfully requested.

If there are any fees necessitated by the foregoing communication, the Commissioner is hereby authorized to charge such fees to our Deposit Account No. 50-0902, referencing our Docket No. 66329/31349.

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Respectfully submitted,



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